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FEB 18 1948

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IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1947.

No. 558.

GENERAL MOTORS CORPORATION,
Petitioner,

v.

ELMER G. KESLING,
Respondent.

BRIEF IN OPPOSITION TO PETITION
FOR A WRIT OF CERTIORARI.

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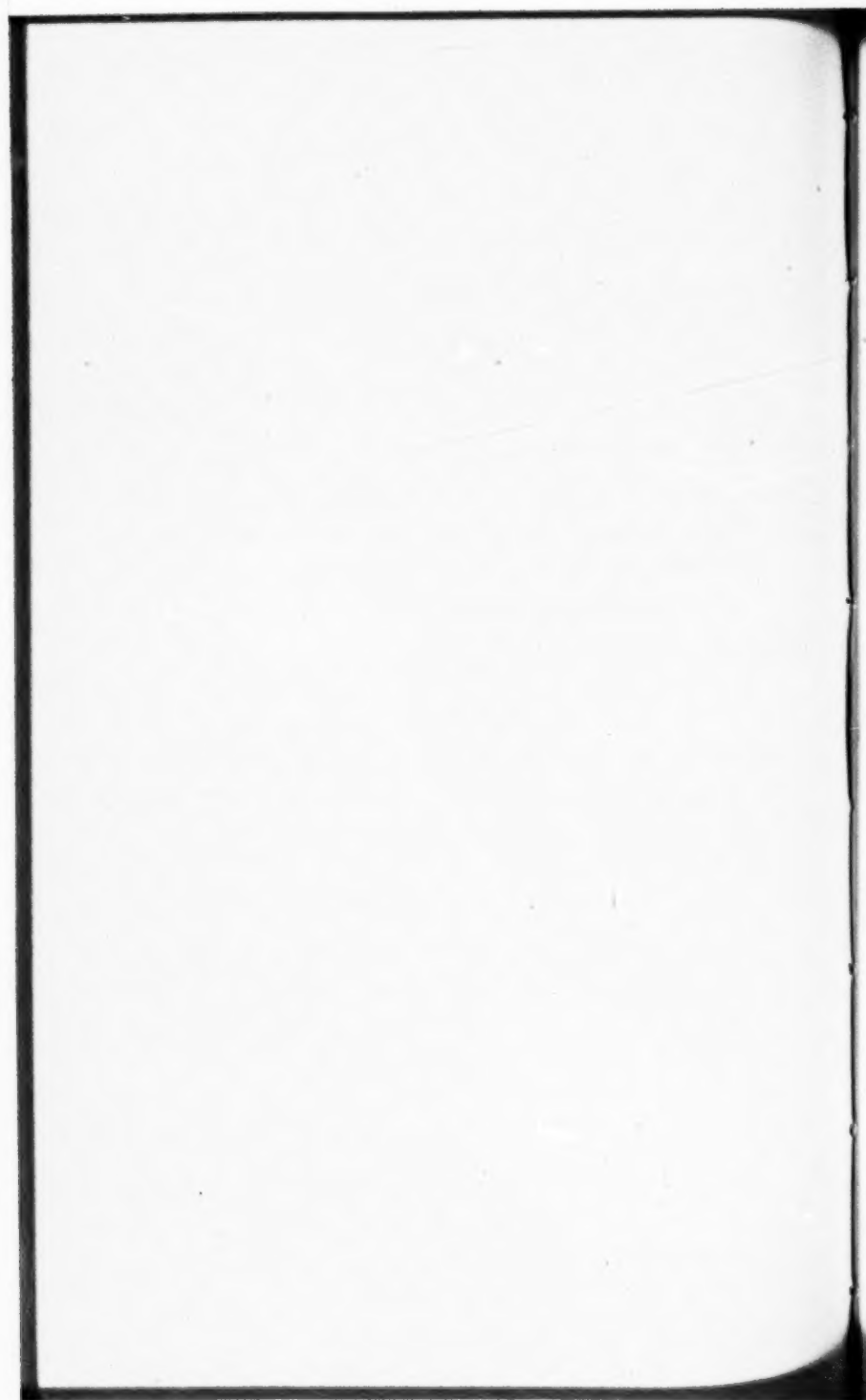
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SUMMARY OF ARGUMENT.

The Courts below have already specifically held against petitioner on every matter raised in the petition. The Court of Appeals, in an opinion by Judge Stone, concurred in by Judges Thomas and Johnsen (R. 671, 164 F. [2d] 824), unanimously affirmed the judgment of the District Court, which Court had filed findings of fact and conclusions of law (R. 635, 66 F. Supp. 1).

Petitioner alleges that there are two "questions presented" by its petition. Both are fully answered by the facts found below:

(1) The claims were found by both Courts below to recite no mere catalogue of elements, but rather a combination of elements, consisting of a handle, a power operating means, a valve, and shifter elements, with an actuator disposed centrally of the operating group and having connections radiating out to all of them. Both Courts below have found that the actuator is a composite device well illustrated by the patent, and having its counterpart in the Chevrolet shifter.

(2) Both Courts below did, as a matter of fact, consider the representations made in the file wrapper; and the Court of Appeals even QUOTED THE VERY LANGUAGE PETITIONER SAYS IT REFUSED TO CONSIDER.

ARGUMENT.

(1) The Kesling Claims Are for Clearly Defined Combinations.

Petitioner contends that the Kesling claims do not define the structure, mode and operation of the parts in combination. The exact contrary was found by the Courts below, which found that the claims define precise interconnections between the handle, the actuator, the shifter element, the piston, and the valve. The Courts below said that the parts are grouped around the actuator, and each part has its connection extending inwardly to the actuator. Finding of Fact 9 (R. 638), by the District Court, states:

“Kesling, for the first time introduced a power shifter for sliding gears wherein the hand participated with the power in effecting the shifting. He embodies this in a mechanism having a hand lever, a vacuum power device, valve mechanism to control the power device, and shifter elements. All of the foregoing were known in the art. But Kesling combined these mechanisms through a composite central mechanism or actuator *from which all of the four operating elements radiated and with which they were all connected*. This actuator was a composite of members arranged to cause the hand lever and the power device to operate in a timed relationship. In the prior art, the power always led the hand so that there was only a power-produced gear movement at the critical point of mesh. In Kesling, this composite actuator assured that there would be manual domination through the first part of the shift which, in the terms of the art, means up through the point of mesh.” (Emphasis added.)

This finding of fact makes abundantly clear that the actuator is disposed at the center of the group of elements, and that the other component elements “radiated” from it. It is in this physical sense only, and in no figurative or legal sense, that the Kesling actuator is at the heart of the combination.

The District Court, in Findings 9 and 11, described the Kesling combination and the illustration in the Kesling patent. Then that Court referred to the claims as follows, in Finding 13 (R. 640):

“The foregoing illustration in the Kesling patent furnishes a basis for Kesling’s claims of a novel combination of elements. This combination consists essentially of a hand operating means, a power operating means, a valve control, and shifter elements, all *connected* to a composite central *actuator* disposed *centrally* of the operating group. This combination, regardless of the details of the individual elements, marks a clear departure made by Kesling over the prior art.”

It is evident that the District Court found the Kesling claimed combination to be more than merely an actuator, and more than merely a catalogue of several elements of which the actuator is one. The District Court found, flatly contrary to petitioner’s present contention, that the Kesling claims were directed to a combination of elements, *all interconnected* in a very definite way.

Not only did the District Court find against petitioner on its contention that the Kesling claims are mere catalogues of elements, without any connections or interrelations, but also the Court of Appeals did likewise.

The Court of Appeals quoted the language of the claims in suit (R. 678-9). In contradiction to petitioner’s argu-

ment that the claims merely catalogue elements without indicating their interconnections or operation in combination, the Court of Appeals said (R. 679):

“ * * * Each of these claims states the physical combination of the various mechanical elements and their functional interrelationship and operation.

“Analysis of any of these claims reveals a *combination mechanical structure* composed of gear shift elements, manually operated elements, power operated elements and an ‘actuator.’ The heart of the combination is the actuator. To it, the shift, the manual and the power elements are *all mechanically connected*. The tie in of the power element is with two parts thereof—the control valve and the piston—with the results that movement of the actuator opens the valve bringing in the power and this power, through movement of the piston, in turn is exerted upon the actuator. Necessarily, manual force must be used to move or to set in motion the actuator to the point where the actuator opens the valve. * * *” (Emphasis added.)

The remainder of these paragraphs is valuable to show how thoroughly the Court of Appeals investigated the precise issue raised by petitioner, and found against petitioner.

The Court of Appeals, discussing claim language, also said (R. 685):

“As to the language of the patent. Each of these five Claims covers an ‘actuator’ to which are *mechanically connected* manual means of moving the actuator; power means to be released by movement of the actuator and which, when released, operates to move the actuator; and gear shifting means moved by the actuator. The starting force which moves

the actuator to the stage when the valve is opened, bringing the power into activity, is manual." (Emphasis added.)

The subsequent paragraphs on the same subject matter might also be quoted here, but for unnecessarily lengthening this brief. The quotations given show quite clearly that the Courts below considered the point petitioner now makes and held that the Kesling claims were not merely catalogues of elements, but were definitions of structure wherein the components were interconnected in particular ways, for particular purposes.

The Courts below ruled upon the alleged issue of identity of the actuator. In Finding of Fact 9 (R. 638), the District Court found:

" * * * He (Kesling) embodied this is in a mechanism having a hand lever, a vacuum power device, valve mechanism to control the power device, and shifter elements. All of the foregoing were known in the art. But Kesling combined these mechanisms through a composite central mechanism or actuator from which all of the four operating elements radiated and with which they were all connected. This actuator was a composite of members arranged to cause the hand lever and the power device to operate in a timed relationship. In the prior art, the power always led the hand so that there was only a power-produced gear movement at the critical point of mesh. In Kesling, this composite actuator assured that there would be manual domination through the first part of the shift which, in the terms of the art, means up through the point of mesh."

In Finding 11 (R. 639), the District Court found:

"The Kesling patent illustrates one embodiment of the Kesling invention, wherein the hand lever, the

valve, the power device, and the shifter elements all are grouped about a composite actuator having connections with all of them. In the illustration, the actuator comprises a shaft that is geared to the hand lever shaft, is geared to the power piston, is cammed to the valve mechanism, and is geared to the shifter elements. The arrangement is such that the hand starts a shifting operation by initiating movement of the actuator (as distinguished from the prior art wherein the hand initiates movement of the valve alone). The actuator is connected with the shifter elements so that this initial movement of the actuator results in the application of a manual shifting force to the gears. In due course, this movement of the actuator, through the connection of the actuator and the valve by the cam arrangement, opens the valve to admit power to assist in the shifting operation. This power is fully introduced in the latter part of the shifting operation—i. e., after point of mesh—so that there is no domination by power of the hand at the critical point.”

While infringement is not one of the primary questions specifically presented by the petition, we note that along with detailed findings of identity of structure, result, and function, between Chevrolet and Kesling, the District Court found (Findings 18, 19, R. 641):

18.

“Chevrolet adopted the principle shown by Kesling, that the hand must do part of the job of shifting in order to have a practical power shifting means. Chevrolet embodied this principle, in the novel combination disclosed by Kesling, of a composite actuator centrally disposed of and *connected* to the hand lever, the valve, the power piston, and the shifter elements.” (Emphasis added.)

19.

“An ‘actuator’ being something that actuates or puts into action or motion or incites to action, the composite linkage of the Chevrolet shifter is properly termed an ‘actuator.’ ”

The Court of Appeals specifically ruled upon the identity of the actuator. Previously quoted sections of the opinion, such as Record page 679 and page 685, show this. And see also (R. 688) :

“In Kesling, hand means are connected to a crank shaft or spindle which is connected to the gear shift means, the power valve control means and the power means piston. It is this spindle with its connections to the gear shift, the valve and the piston which make up the actuator. * * * ”

And page 689:

“What Kesling taught broadly was that this hand control at the critical shifting point and use of power force in the shifting operation could be accomplished by harnessing hand force, power force and shifting elements together through a focal unit which would produce these desired uses of power and hand control and which he calls an ‘actuator.’ His preferred form showed such construction.”

And, speaking of the Chevrolet shifter, the Court of Appeals said (R. 690) :

“* * * This composite interlinkage of these three ‘levers’ was found by the trial court to be an actuator. This finding is sound.”

The sophistry of petitioner’s argument that the actuator is not identifiable is shown by the fact that petitioner itself identified the actuator from its first reading of the Kesling

patent. Before the trial was ever begun, petitioner prepared its own Defendant's Exhibit S, all without aid from anyone. At the trial, petitioner offered this exhibit in evidence. The exhibit is a colored drawing of the Kesling structure, whereon petitioner itself had carefully painted, what it already knew to be the actuator, a brilliant red (R. 541).

Everyone who has been involved in this case has identified the actuator with no trouble. This includes the parties and the four judges of the two courts—not to mention the Patent Office. Petitioner is simply in no position to make an argument at this late stage that it cannot identify the actuator. Its own actions speak too loudly.

Petitioner argues that the word "feel" is not mentioned in the Kesling patent. This is true, but, as both Courts have already specifically ruled, "feel" is merely a word of convenient summary of a longer explanation in the Kesling patent itself. The District Court Finding of Fact 21 is:

"Kesling discloses the central composite actuator in combination with the four actuating elements of this combination wherein the hand controls the first part of the shift. The evidence supports the fact that to the transmission art, the division of a gear engaging operation is at point of mesh. Kesling clearly introduced into the art the manual control of the shift at this point. No shift of the prior art without this feature apparently was mechanically successful. And in this respect Kesling discloses that 'feel' would be present at the point of synchronization."

Also, in Finding 11, the District Court described the structure and operation of the patented shifter in detail, and then found (R. 639, 640):

“The construction affords a continuous mechanical connection between the hand of the operator and the gears being shifted. By this, the operator may feel the gears into mesh. By the connection of the hand lever, as well as the power piston and valve to the actuator, the hand may control the shift at point of mesh and prevent a forced engagement of the gears.”

Petitioner's argument was also made to the Court of Appeals, who answered it in detail (R. 681-2), devoting a whole section of the opinion to “Feel.” Petitioner, quite inexcusably we think, mentions the statement of the Court that the patent does not contain the word “feel,” without even suggesting that the opinion explained at great length that the longer explanation of the patent means the same thing. The opinion (R. 682) holds:

“(1) The patent nowhere contains the word ‘feel.’ However, the teaching of the patent clearly reveals such when it is read by one skilled in the art. One so skilled would know the problem Kesling was trying to solve. Briefly, that problem was to overcome the defect in all prior attempts to apply power to this style of shift. Prior attempts had been to employ power throughout to do the entire work of shifting. The defect in such method was the insensibility of power to this critical point in the shift when the gears come into initial contact. The skilled person would know that the main reason for Kesling keeping sufficient hand control at this critical point would be to remedy this defect. The skilled person would know the remedy would be ineffective without this ‘feel.’ For Kesling to express in the patent this matter of ‘feel’ would be stating what anyone skilled in the art would know already. The presence of the appreciation of ‘feel’ by Kesling is necessarily implied. This impli-

cation is emphasized by the language of the Specifications describing the operation of the preferred structure and by the language of most of the Claims which bring in the power after the 'initial' gear movement or at the 'final' movement."

No one has ever contended that Kesling was the first to provide feel in a sliding gear transmission. Feel was inherent in all manual shifters. Kesling was the first to provide a power shifter having a mechanism that would retain this feel and yet provide power for the shifting operation.

Respondent assumed the burden of proving that the accused Chevrolet shifter and the Kesling shifter operated in substantially the same way, to attain the same result, by substantially the same means. The District Court found in detail as to the structure and operation of both the Kesling and the Chevrolet shifter, which findings establish their identity. Finding 23 is only a summary of the previous findings, but it clearly shows that the trial Court found identity of result, identity of means, identity of interoperation of means between the patented and the accused device. This Finding 23 is (R. 642):

"The present claims are not limited by the art beyond the obvious meaning of their words. At this level, it is clear that the Chevrolet structure attains the same result—a power-aided shift of sliding gears—by substantially the same means—a composite actuator centrally disposed with respect to the manual means, the power piston, the valve, and the shifter element—the means cooperating in the same way—by providing a continuous manual (mechanical) connection between the hand of the operator and the gear, as well as the valve, so that manual feel and manual control at point of mesh may be had."

The Court of Appeals opinion states (R. 687):

“The parties agree that to constitute infringement the accused device must, in a patent sense, accomplish the same result and by the same means and by the same method of operation (citations). There is agreement that, if any one of these requirements is lacking there is no infringement (citations). Appellant contends that its device does not produce the same result nor by the same means nor by the same method of operation.”

Thereafter the Court of Appeals devotes separate sections of its opinion to “Result,” “Means,” and “Method of Operation,” finding identity between the accused and patented device, as to all three. At page 690, the Court of Appeals said:

“Kesling’s actuator consists of a hand moved spindle or shaft connected by cams and gears with the valve, the piston and the shift gears in such manner as to produce cooperative action resulting in retaining hand ‘feel’ and control past the critical shifting point. Appellant’s actuator consists of a shaft connected to links and levers and producing the same desirable results. Cams and gears and links and levers, as well as their functions and operations, are old in mechanics and, within the scope of this patent, are equivalents known to skilled mechanics. The finding of the trial court to this effect is sustained.”

Clearly both Courts below have already treated the matter of infringement from the most strictly proper legal basis, so that petitioner’s argument here is but a reargument. Certainly petitioner’s argument that the Chevrolet shifter is wholly unlike Kesling’s shifter in structure, function, or result is in direct opposition to the exact fact findings of both lower Courts.

It should be evident that the present patent and its claims are entirely distinct from those in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1. The claims in suit specify a combination of elements, all having definite interconnection. As both Courts below have held, Kesling did not claim novelty in the bare catalogue of elements, but only in those elements interconnected in a particular way. Kesling did not attempt to predicate novelty merely on the addition of an "actuator" to old elements. Nor do the claims at issue rely upon a "means" clause that employs conveniently functional language at the point of novelty. They recite identifiable mechanical components. The physical structure of the actuator, and the interrelation of the several parts, including the actuator, to each other, and the manner in which the parts interoperate, are all clearly set forth in the claims, in terms unmistakable and unmistakable.

Kesling cannot stop use by others of the "catalogue" of elements of his claims, *except when others also provide the specific interconnections* required by the claims. All of the claims are for particular components, particularly interconnected. Anyone who can obtain the same result by the same elements differently connected is free of the patent. And anyone who can obtain the same result by different elements, regardless of interconnections, is free of the patent.

The Kesling claims are of the type approved by this Court in the *Halliburton* case, because they "structurally described the physical and operating relationship of all the crucial parts of the novel combination." As both Courts below have already held, and as is obvious from a reading of the claims in suit, those claims insist upon certain physical components, all interconnected in a particular way, so that, as the Court of Appeals said, the ac-

tuator is located at the heart of the group of elements, with connections to each radiating outwardly from the actuator to such element.

(2) The File Wrapper Matter.

Petitioner contends that the Courts below, contrary to decisions of this and other Courts, refused to consider statements of argument presented by Kesling to obtain allowance of his claims.

The answer to this quite false contention is that both Courts below did consider the very file wrapper statements upon which petitioner relies.

Petitioner's contention is astonishing. Respondent quoted the statements in question in his District Court brief and discussed them. Petitioner quoted and discussed them in its trial Court brief. Petitioner quoted the language and discussed it in its Appellate Court brief. Respondent did likewise. The Court of Appeals quoted the language in its opinion (R. 683-4).

In the face of the utter impossibility for either lower Court to have refused to consider language so thoroughly presented to them, and argued before them, petitioner's point is a creation out of thin air.

Of course, the answer is that the language in the file wrapper does not have the meaning petitioner attributes to it. Respondent quoted it because, in our opinion, it indicates a distinction over the art found in *both* Kesling and Chevrolet. Both Courts agreed that, as a matter of fact, it does just that (cf. R. 686-7). The "timed relationship" is present in both. Petitioner contends that Chevrolet has no such timed relationship. There were demonstrations in the trial Court proving it to be true.

In at least one lower Court brief, petitioner admitted it. And the Court of Appeals certainly found the timed relationship in the Chevrolet shifter. Note, for example, the timing of the manual and power movements discussed in the following portion of the opinion below (R. 692):

“The method of operation of the accused device is as follows. Manual force initiates and continues throughout the entire shift operation. This manual force is first communicated to the valve lever which starts opening the valve port; continued manual pressure on the valve lever takes up any ‘lost motion’ clearance in the linkage between the valve lever and the reaction lever then causing movement of the reaction lever; still continued manual pressure takes up any ‘lost motion’ clearance in the linkage of the shifter lever then causing the shifter lever to start moving the gear shift elements; power force comes into exertion (through the piston rod connection to the reaction lever) upon the reaction lever and, through linkage, upon the shifter lever at least as early as the beginning of movement of the shifter lever; the combined manual and power force continue the shifting movement to completion or until halted by withdrawal of manual force. The manual force is necessary not only to initiate the entire shifting operation but also continuously until the operation is completed. * * *”

The remainder of this section of the opinion brings out the same timed relationship.

There is no real issue on the file history language. It was specifically considered below.

CONCLUSION.

Petitioner has raised two entirely false and non-existent questions.

The first question created by petitioner is that the claims are indefinite in the *Halliburton* sense. This is quite untrue, as the consistent rulings of the Courts below have held. Petitioner's repetition of such expressions as "sweeping generality of the term 'actuator'," and "promiscuity" of the term, and "term of such versatility" and "verbal hocus pocus," is not based upon any deficiencies in the Kesling claims or in the opinions below. It is, we suppose, catch phraseology designed to give the impression that the Courts below have done violence to established principles, in deciding the case for respondent.

But there is not the slightest evidence in support of this freely used catch phraseology. For Kesling's claims, as is evident from their language, and from the findings of the District Court, and from the opinion of the Court of Appeals, all require full combinations of fully interconnected elements that attain new results. They are not claims to merely an actuator; they are claims that require specifically that the actuator have connections of delineated type with each of four other elements of the claim, all for indicated purposes. And they are infringed only by a shifter that has these same components similarly interconnected, for the same purpose. On this basis, both Courts below held that the Chevrolet shifter infringes.

There is no truth to petitioner's alleged "question" that the Court of Appeals refused to consider language of the file history. The Court actually quoted (R. 683) the very language in question, in its opinion, and discussed its meaning (R. 686).

In closing, may we say that the findings of the trial court and the opinion of the Court of Appeals (R. 637, 677, 685) are that the prior art had sought a power shifter for over twenty years. Numerous efforts all resulted in failure. Only when Kesling described the principle of manual domination of power at point of mesh, and that mechanical connection that affords what, for simplicity, we call "feel," and only when Kesling illustrated a mechanism that would embody that principle, was there ever a commercially successful power shifter.

Even Bendix and General Motors had tried, and met failure. Bendix tried Moorhouse and met failure. Then Bendix, after having seen the Kesling disclosure with its novel arrangement, employed the Kesling combination, with its components and connections, and sold over 2,500,000 units (R. 690, referring to R. 297, 554).

It is submitted that there is justification for the decisions below, and that there are no real issues presented by the petition. We suggest that to delay the matter further for mere reargument of old fact issues is to require of respondent more delay and expense than should be required of him.

Respectfully,

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